of issues reproduced on multiple discs, *National Geographic* is the only periodical that appears in the CD-ROM version. A user encounters very few materials that have been added to the CD-ROMs that are not digital facsimiles of the original magazines or software that permits viewing them[4] and searching them for specific issues and articles. These added materials perceptible to users include (depending on which version of the NGS is at issue) a few short advertising videos, a start-up video montage that lasts for a few seconds, an introductory tutorial, a chronological table of contents, very short article summaries in lists of search results, and links to the National Geographic Society website.[5] Pet. App. 6a; 40a-41a and n.23.

Thus, the freelance contributions are reproduced and distributed to the public "as part of" the original collective work or revision of the original collective work. The freelance contributions are not being made available on a piecemeal basis or being sold a la carte out of a database that combines multiple periodical titles. *Cf. Tasini*, 533 U.S. at 489, 499-500. The contributions are not stored and retrieved "separately within a vast domain of diverse texts" (*id.* at 503) and thus, the reproduction and distribution of the contributions in the context of digital facsimiles of the original periodicals do not effectively override the contributors' exclusive right to control the individual reproduction and distribution of each contribution. *Cf. id.* at 503-04. In all material regards, the contributions are perceptibly reproduced as part of the digital facsimiles of the

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4. There are minor variations among succeeding versions of the CNG. For instance, later versions of the CNG also apparently include software tools, such as tools to darken text for easier reading, to rotate images, bookmark pages, and similar capabilities. Pet. App. 6a.

5. *Amici* submit that, as the Second Circuit held, for purposes of Section 201(c) these additional elements are merely incidental and of no significance to the status of the CNG as a qualifying reproduction. *See* Pet. App. 21a. They do not alter the essence of the digital facsimiles embodied in the CNG and have no separate value to the product's user. They are of no greater significance than putting a new cover on a book or adding a table of finding aids to the head of a microfilm roll.

original *National Geographic* magazines. These CD-ROMs are therefore materially distinguishable from each of the products at issue in *Tasini*.

B. The Flaws In The *Greenberg* Analysis

The Second Circuit rightly rejected the reasoning of the Eleventh Circuit's decision in *Greenberg* because that decision failed to reflect the relevant distinctions between the product at issue before it (and before this Court) and those at issue in *Tasini*. The *Greenberg* opinion also erroneously suggested that it is impermissible under Section 201(c) for a collective work owner to combine into a single product the digitized text and images of a complete collective work with software that enables users to perceive and search the collective work with the aid of a computer. Under the Eleventh Circuit's reasoning, the addition of search and access software to a product containing digitized periodicals is in effect *per se* impermissible under Section 201(c). The court had claimed in its opinion not to decide that issue. 244 F.3d at 1273 n.12. However, the software issue was clearly the dominant element of its analysis. *See id.* at 1273. Under the *Greenberg* reasoning no publisher can rely on Section 201(c) to release a collection of its works in CD-ROM or digital format because of the need for and use of supporting software. *Amici* believe this analysis to be an error that could materially diminish public access to works and reduce the dissemination of collective works reproduced and distributed in digital form in a manner consistent with Section 201(c) as explained in *Tasini*. Indeed, in view of the Petitioners' nearly palpable fear of digitization in general (*see, e.g.*, Psihoyos Pet. (05-490) at 3, 6, 18-19; Faulkner Pet. (No. 05-506) at 14-15; Ward Pet. (No. 05-504) at 2, 16-17, 23; *see also* Pet. App. 69a n.91), it is clear that they desire this result.

In the CNG, the original collective works that are reproduced in digital facsimiles are not themselves changed by the conversion from paper to CD-ROM. In this regard, there is merely a transformation from analog to digital media. The necessity of using an additional "work", i.e., another computer

program, to view the unchanged collective works should be analytically irrelevant because under the Act, a copy of a work that is perceptible *without* a machine or device stands on equal footing with a copy that is perceptible *with* one. The Act provides that copyright protection adheres to works of authorship "fixed in *any* tangible medium of expression, *now known or later developed*, from which they can be perceived, reproduced, or otherwise communicated, either directly or *with the aid of a machine or device*." 17 U.S.C. § 102(a) (emphasis added). *See also* 17 U.S.C. § 101 ("copies" defined as material objects in which a work "is fixed by *any* method *now known or later developed*, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or *with the aid of a machine or device.*") (emphasis added).

The CNG embodies digital fixations that are materially similar to the type of analog microfilm collections that this Court has already observed are permissible under Section 201(c).[6] The freelance contributions are perceptible to the end users of this product "as part of" the original collective works, just as they are to the end-users of a roll of microfilm. The end-user encounters the software component of the product in effect only as part of the "machine or device" that permits the collective work to be perceived. It is functionally analogous to a lens, light, and the knobs on a microfilm viewer. It is not perceptibly presented to the end user as matter that has been added to the original collective works.

Even if the CNG were not to be viewed as embodying mere reproductions of the original collective works, the addition of these software elements to the digital medium could be viewed

6. "Microforms typically contain continuous photographic reproductions of a periodical in the medium of miniaturized film. Accordingly, articles appear on the microforms, writ very small, in precisely the position in which the articles appeared in the newspaper." *Tasini*, 533 U.S. at 501. "True, the microfilm roll contains multiple editions, and the microfilm user can adjust the machine lens to focus only on the Article, to the exclusion of surrounding material. Nonetheless, the user first encounters the Article in context." *Id.*

as the creation of a permissible "revision" under Section 201(c). As the Second Circuit recognized, the concept of a "revision" can encompass some level of addition and/or deletion of copyrightable matter. Pet. App. 21a. Neither the Act nor its legislative history suggest otherwise.[7] If the "final" edition of a traditional print newspaper contained additional photographs and text – both qualifying as additional copyrightable works – absent from the "early" edition, this could be fairly characterized as being a permissible "revision." Likewise, adding copyrightable matter that is not perceptible to end users as matter added to the collective work being viewed, but encountered as part of the "machine or device" that enables them to search and view the collective work, could be fairly deemed to be a "revision" of the collective work.

II. Failure To Review The Decision Below Would Adversely Affect The Library And Archival Communities And Collective Work Users

A. Adverse Effects

This Court's resolution of the conflict between the circuits would have far-reaching implications beyond the parties to this case and its impact would not be isolated to collective work copyright owners and contributors. It would also have profound consequences for the library and archival communities and those who use collective works. For *Amici*, *Greenberg* was ominous. Under it, no collective work reproduced or distributed via CD-ROM, online technology, or other new technology requiring additional software to facilitate viewing or searching could ever qualify for the Section 201(c) privilege as a practical matter even if the product met the statutory criteria in all other respects. *Greenberg* therefore inhibits the dissemination of collective works via digital and electronic media. Such products make it much easier to access information resources, and make possible

7. *See* H.R. REP. NO. 94-1476, 94th Cong., 2d Sess. 122-23 (1976), *reprinted in* 5 U.S.C.C.A.N. 5659, 5738 (1976) (under 201(c) a publishing company could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it).

the retrieval and use of data in powerful ways not possible with analog media. They are of enormous value to library patrons, particularly students, scholars and historians, and nothing in Section 201(c) or *Tasini* should be understood to deprive these users completely of such powerful tools.

The sweeping implication of the Eleventh Circuit's decision would, if left undisturbed, thwart broader public availability not only of well-disseminated works like those of National Geographic. Access to more obscure, less widely accessible magazines, newspapers, scholarly journals and other periodicals would also be frustrated. These collective works could potentially be made accessible to a broader segment of the population, but not if digital and electronic media compilations of them are effectively *per se* impermissible under Section 201(c), as they appear to be under *Greenberg*.[8]

The strong public and scholarly interest in such periodicals is evidenced by the fact that digital replicas of public domain works, including collective work periodicals, are being made available online for no fee at an increasingly rapid rate. *See, e.g.*, Library of Congress, The Nineteenth Century in Print: Periodicals[9] (listing titles and years of complete digital facsimiles of historic nineteenth century periodicals digitized by Cornell University Library and the Preservation Reformatting Division of the Library of Congress); Bruce Cole, "The National Digital

8. Although the petitioners in *Tasini* voiced similar public access concerns in that case, this Court found that those concerns could not override the language of Section 201(c) as applied to the specific products at issue in that case and recognized that the question of continued public availability of those works could be addressed in the context of the remedial phase of the case. *Tasini*, 533 U.S. at 504-06. But in this case, the product is distinguishable from those in *Tasini* and a fair application of the statute requires a different outcome. No remedy is needed because the collective work copyright owner has committed no wrong.

9. *At* http://memory.loc.gov/ammem/ndlpcoop/moahtml/snctitles.html (last visited Nov. 16, 2005).

Newspaper Program"[10] (Organization of American Historians and Library of Congress partnership to convert microfilm of historic U.S. newspapers into digital files, to be permanently available through the Library of Congress via the Internet); Brooklyn Public Library, *Brooklyn Daily Eagle Online*[11] (online digital facsimiles of the Brooklyn Daily Eagle from 1841-1902, digitized by the Brooklyn Public Library); J. Willard Marriott Library at the University of Utah, Utah Digital Newspapers[12] (online digital facsimiles of pages from Utah newspapers freely available on the Internet, digitized by the J. Willard Marriott Library at the University of Utah); Press Release, University of Richmond, "University of Richmond Library Receives $478,141 Grant to Create Digital Database of Civil War-Era Newspapers" (Oct. 13, 2003)[13] (project to digitize newspapers from both Union and Confederate perspectives from 1857-1865). There is also substantial demand for, and utility to libraries and their patrons from the availability of, digitized replicas of collective works that are still subject to copyright protection and only available with the authority of the collective work copyright owners. *See, e.g.*, JSTOR, The Scholarly Journal Archive[14] (detailed listing of scholarly journal titles and years available; includes public domain and copyrighted material).[15]

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10. *At* http://www.oah.org/pubs/nl/2004may/cole.html (last visited Nov. 16, 2005).

11. *At* http://www.brooklynpubliclibrary.org/eagle/index.htm (last visited Nov. 16, 2005) and http://eagle.brooklynpubliclibrary.org/Archive/skins/BE/about.htm (last visited Nov. 16, 2005).

12. *At* http://www.lib.utah.edu/digital/unews/ (last visited Nov. 16, 2005); *see also* http://www.lib.utah.edu/digital/unews/ (last visited Nov. 16, 2005) (about the program).

13. http://oncampus.richmond.edu/news/press/oct03/grant.html.

14. *At* http://www.jstor.org/about/alpha.content.html (last visited Nov. 16, 2005).

15. When digital facsimiles of print materials are made accessible via the World Wide Web, the widest range of users have equal access to collections from any location whether they are on- or off-site. A virtual

(Cont'd)

The decision in *Greenberg*, unless overruled, will also have an adverse impact on preservation efforts. These are closely related to but distinct from access concerns. Cultural institutions serve the international community by building, protecting, preserving and ensuring continued access to diverse collections and resources. The challenges of preserving collections have been addressed in different ways over time. Libraries have used conservation to preserve the original artifact and reformatting strategies, such as microfilm and print facsimiles, to retain content, enhance access, and protect the original from excessive wear. Over the past several years, libraries have moved toward using digitization as an additional, and in some cases, a preferred method for reformatting endangered and fragile paper-based materials to both preserve and provide access to library collections.

Effective use of digitization frequently involves both creating complete, digital facsimiles of a collective works, and combining the digital facsimiles with computer software (that is itself comprised of one or more separate "works" under the Act) that enables users to view and search the collective works with the aid of a machine or device. Indeed, libraries make significant investments in supporting the development of technologies with the goals of improving both user access and long-term preservation capabilities. The *Greenberg* decision stymies the adoption and evolution of such media to the detriment of the public in both regards.

Along with access and preservation concerns, *Amici* institutions face ever-escalating demands on their physical space and economic resources. CD-ROM and online versions of newspapers and magazines now – and eventually other products

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(Cont'd)
environment of digital files can combine content from many kinds of resources including primary source material, and provide powerful opportunities to integrate materials seamlessly into instruction and course management systems for teaching and learning. Digitization allows users to create virtual collections that will support new and creative research made possible only in a digital environment.

yet to evolve – can greatly reduce the space requirements of many libraries. Thus, if this Court fails to take this opportunity to reject the reasoning of *Greenberg*, such institutions would suffer adverse impacts on their space requirements and face potentially huge increases in costs of operation and maintenance. This would have the collateral effect of reducing the amount of material and variety of sources easily available to library patrons. It would also needlessly impose on collective work copyright owners the obligation to locate,[16] negotiate with, and pay additional compensation to contributors (or their heirs or assigns), a requirement that could dramatically drive up the ultimate cost of digital resources for libraries and similarly situated institutions.[17] This is not an outcome that Section 201(c) requires and therefore constitutes an additional, avoidable harm to libraries and their patrons.

B. Litigation Risks To Publishers Exacerbate The Adverse Effects Of *Greenberg*

Notwithstanding this Court's decision in *Tasini* or the Second Circuit's decision below, the Eleventh Circuit's decision in *Greenberg* is likely to remain the de facto law of the land and the publishing world, even if no other circuits follow it, unless and until this Court overrules it. Few publishers are likely to have a commercial interest in publishing digital versions of their

16. In a recent study by the Carnegie Mellon University Libraries to determine the feasibility of acquiring permission to digitize copyrighted material in their collections and make it available on the Internet, only about half the requests to a sample of several hundred copyright holders resulted in yes/no answers, nearly a third of holders who received a request letter did not respond at all, and addresses were never found for about eleven percent of the holders. Carole A. George, Carnegie Mellon University Libraries *Exploring Feasibility of Seeking Copyright Permissions* (2002), *at* http://www.library.cmu.edu/Libraries/FeasibilityStudyFinalReport.pdf.

17. Collective work copyright owners might also choose to forego these additional transaction costs and delete freelance submissions from digitized works, or not produce them at all. Either outcome would harm libraries and their patrons.

collective works in less than the entire country. Any publishers contemplating doing so would seek to avoid reproducing and distributing their collective works in any manner that would likely subject them to copyright infringement lawsuits in federal district courts in the Eleventh Circuit. For some this may mean that they will risk making digital products only available in New York, Connecticut and Vermont. Others may risk the uncertainty of making those works available everywhere outside the Eleventh Circuit. If the "best case" result of the present circuit split would be that students, scholars, and other library patrons in Albany, Georgia will not have access to the same resources that are available to those in Albany, New York, this would clearly be at odds with the goals of the federal copyright laws.

Even this unacceptable result is less likely, however, than the prospect that the vast majority of publishers will avoid the litigation risk altogether and choose not to bring digital versions of their collective works to the marketplace. Even the most careful distribution model might still subject a publisher or its distributors to being haled into court in Alabama, Florida, or Georgia and held liable under the flawed standard of *Greenberg*.[18] The federal venue statute for copyright cases provides that copyright infringement suits "may be instituted in the district in which the defendant or his agent resides or may be found." 28 U.S.C. § 1400(a). "It is well settled that,

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18. Respondents note that they cannot "realistically publish a work that is lawful in three States but unlawful in three others." Respondents' Br. at 1. This assessment may be unduly optimistic: for a defendant being sued in the Eleventh Circuit the work would not be lawful in *any* states. *See Murphy v. Federal Deposit Ins. Corp.*, 208 F.3d 959, 964-66 (11th Cir. 2000) (in cases where federal law is at issue transferee courts are obligated to follow their own interpretation of the relevant law and the binding precedents of their own circuits, not conflicting interpretation of the relevant law binding on the courts in the transferor court's circuit); *Eckstein v. Balcor Film Investors*, 8 F.3d 1121, 1126 (7th Cir. 1993) (the norm is that each court of appeals considers questions of federal law independently and reaches its own decision, "without regard to the geographic location of the events giving rise to the litigation.").

based upon this language, venue in copyright actions is coextensive with jurisdiction. . . . In other words, where there is jurisdiction, there is venue." *Foxworthy v. Custom Tees, Inc.*, 879 F. Supp. 1200, 1207 (N.D. Ga. 1995). Therefore, even acts outside the states in the Eleventh Circuit could conceivably subject a publisher to a lawsuit in a district court within that circuit if a state's long-arm statute so permits because of harm to the intangible intellectual property rights of an author who lives in that state[19] and the exercise of personal jurisdiction over the publisher is consistent with the Due Process Clause.[20] Under

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19. *See Cable/Home Communication Corp. v. Network Productions, Inc.*, 902 F.2d 829, 857 (11th Cir. 1990) (former Fifth Circuit stressed that breach of common law copyright subjects wrong-doer to liability in tort within the reach of Florida long-arm statute; long-arm statue not limited to act in Florida causing injury in Florida, but includes situation in which foreign tortious act causes injury within forum) (internal citations and quotations omitted).

20. A district court in the Eleventh Circuit could be asked to assert specific personal jurisdiction over a publisher for activities outside the forum were a collective work contributor to allege that the publisher's actions were tortious, deliberate, and with knowledge at the time that the publisher committed the alleged tort that the contributor would be injured in that state. *See, e.g., Alfa Corp. v. Alfagres, S.A.*, 385 F. Supp.2d 1230 (M.D. Ala. 2005) (holding district court in Alabama could exercise personal jurisdiction over foreign defendant in trademark infringement suit consistent with long-arm statute and Due Process Clause when defendant used mark despite awareness of Alabama plaintiff's mark; defendant could reasonably anticipate that primary effects of conduct would be felt in Alabama); *see also Calder v. Jones*, 465 U.S. 783, 788-89 (1984) (California jurisdiction over Florida defendant held proper in libel action based on injurious effects of Florida conduct on California-based plaintiff's professional reputation and emotional distress suffered in California). In some cases, a publisher might be subject to a state's exercise of general jurisdiction over it if the publisher's contacts with a state are so "substantial" or "continuous and systematic" that it can be haled into court in that state in any action, even if the action is unrelated to those contacts. *See Helicopteros Nacionales de Columbia, S.A. v. Hall*, 466 U.S. 408, 414-15 (1984); *Perkins v. Benguet Consol. Mining*

(Cont'd)

the circumstances, risk-averse publishers have a strong motivation to refrain from publishing digital versions of their collective works, despite the Second Circuit's favorable ruling below, lest they be confronted with the prospect of nationwide injunctions against the accused products (17 U.S.C. § 501), and paying to contributing authors substantial damages and/or attorney's fee awards available under the Copyright Act. *See* 17 U.S.C. §§ 504-05.

CONCLUSION

For the foregoing reasons, even though *Amici* believe that the judgment of the court of appeals should be affirmed, this Court should grant the writs of certiorari as to the question presented in the first page of Respondents' Brief.[21]

Respectfully submitted,

CARL H. SETTLEMYER, III
Counsel of Record
ARNOLD P. LUTZKER
ALLISON L. RAPP
LUTZKER, LUTZKER & SETTLEMYER LLP
1000 Vermont Avenue, N.W., Suite 450
Washington, DC 20005
(202) 408-7600

Counsel for Amici Curiae

November 17, 2005

(Cont'd)

Co., 342 U.S. 437, 446-47 (1952); *see also Borg-Warner Acceptance Corp. v. Lovett & Tharpe, Inc.*, 786 F.2d 1055, 1057 (11th Cir. 1986).

21. Like Respondents, *Amici* believe that the other issues raised by some of the Petitioners are not appropriate for this Court's review in light of the lack of any conflict between the Second Circuit's decision and any other court, including this Court, and the correctness of the Second Circuit's ruling on these other issues. See Respondents' Br. at 11-12.

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IN THE

Supreme Court of the United States

DOUGLAS FAULKNER, *et. al.*,
Petitioners,

—v.—

NATIONAL GEOGRAPHIC SOCIETY, *et al.*,
Respondents.

FRED WARD,
Petitioner,

—v.—

NATIONAL GEOGRAPHIC ENTERPRISES, INC., *et. al.*,
Respondents.

PSIHOYOS, *et. al.*,
Petitioner,

—v.—

NATIONAL GEOGRAPHIC SOCIETY, *et. al.*,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

BRIEF OF *AMICI CURIAE* JOHNNY AUTERY; HERB GREER; THE ESTATE OF LOREN McINTYRE; TOM NEBBIA; PHIL SCHOFIELD; NICK SEBASTIAN; WALTER A. STARCK II; LYNN STONE; RICHARD SWANSON; CATHERINE URSILLO; AND ADAM WOOLFITT IN SUPPORT OF THE PETITIONS FOR CERTIORARI

SURJIT P. SONI
THE SONI LAW FIRM
55 South Lake Avenue, Suite 720
Pasadena, California 91101
(626) 683-7600

Attorney for Amici Curiae

November 21, 2005

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INTERESTS OF *AMICI CURIAE*[1]

Johnny Autery, Herb Greer, the Estate of Loren Mcintyre, Tom Nebbia, Phil Schofield, Nick Sebastian, Richard Swanson, Catherine Ursillo, and Adam Woolfitt ("*Amici*") are among the Plaintiffs in *Auscape, et. al. v. National Geographic Society, et. al.* currently pending in the Southern District of New York (Case No. 02 Civ. 6441(LAK)). Each *Amici* licensed text and/or photographs for use in the National Geographic Magazine ("NGM") and their works were subsequently used without their permission in the same digital Complete National Geographic ("CNG") Products at issue in these appeals.

Amici's works were produced on assignment and on their own initiative. *Amici* typically retain copyright or have their copyrights returned to them after initial publication so they may exploit their full value. Control over further dissemination of the works is essential to their economic survival. *Amici* rely on their copyrights for their livelihood, their retirement, and to pass to their heirs.

National Geographic Society ("NGS") purchased rights to use *Amici's* works for single print publication. Sums paid by publishers to Authors, including *Amici,* were never designed to compensate them for reuse. NGS now seeks to invoke the §201(c) "privilege" to avoid paying for such reuse.

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[1] Counsel listed for *Amici* authored the brief in whole. Counsel for *Amici* did not represent any party to these actions in the District Court or in the Court of Appeals but has appeared as counsel for the *Faulkner* parties in their Petition to this Court. No persons or entities, other than *Amici*, its members or its counsel, made any financial contribution to the preparation or submission of this brief.

The success of these re-publications is largely dependent on the appeal of *Amici*'s content. *Amici* seek to participate in new markets for the reuse of their previously published works in new media to secure new sources of income. Unless the decision below is reversed, *Amici* and other similarly situated authors will sustain direct and pecuniary losses and will not share in the future economic exploitation of their works.

Judge Kaplan, who adjudicated the *Faulkner, Hiser, Ward* and *Psihoyos* cases for which review is sought, also presides over the *Auscape* case. J. Kaplan has not ruled on motions for summary judgement filed in May 2003 by the parties in *Auscape*. On January 21, 2004 J. Kaplan held that:

> The principal . . . issues presented by [the Auscape] case . . . are substantially common to it and to Faulkner . . . The disposition of those issues on the direct appeals are likely to be dispositive of the identical and similar issues here.

J. Kaplan also has still not ruled on *Amici's* March 4, 2004 request he adopt his rulings from the *Faulkner/Hiser/Ward/Psihoyos* cases, stay the balance of the *Auscape* case and certify it so that the Auscape plaintiffs could participate in this appeal. By his refusals, Judge Kaplan has denied *Amici* their due process rights since he has expressed an intention to give this Court's decision in this case preclusive effect against the Auscape Plaintiffs.

Accordingly, *Amici* have a direct and immediate interest in this case and its outcome.

All parties have consented to the filing of this brief. Copies of the letters of consent are submitted herewith.

QUESTION PRESENTED BY THE PARTIES

1) When is a product incorporating pre-existing works a revision of any one of those pre-existing works rather than a new work?

ADDITIONAL QUESTIONS PRESENTED BY *AMICI*

2) Did the Second Circuit correctly construe 17 U.S.C. §201(c) to mean that authors and publishers can only contract to grant publishers more rights to re-use works included in collective works than are afforded by the statutory privilege and that the publishers privilege can only be eliminated by explicit agreement?

3) Is the privilege provided by 17 U.S.C. §201(c) personal or is it alienable?

4) Did this Court's decision in *New York Times Company v. Tasini*, 583 U.S. 483 (2001) expand the exemptions from infringement liability for archival microfilming provided in 17 U.S.C.§108 to permit production and distribution of microform products for commercial gain?

STATEMENT OF THE CASE

Amici adopt by reference the Statements of the Case submitted by the Petitioners.

SUMMARY OF THE ARGUMENT

Amici are requesting this Court to accept *certiorari* to decide the questions raised by the Petitioners and Respondents as well as the questions identified herein.

The questions raised herein formed the basis of the Second Circuit's decision, were essential to the outcome or so guided the court's reasoning that a review without addressing these questions would not provide necessary guidance. The Second Circuits' findings and conclusions as to these questions subvert the purposes of the Copyright Act and Article 1, § 8, cl. 8 of the Constitution. The Second Circuit's rulings on these questions misapplies this Court's teachings and is a complete departure from established principles of law.

The Second Circuit's decision:

- requires authors to explicitly eliminate the 17 U.S.C. §201(c) privilege in their contracts with publishers, notwithstanding the section's explicit reservation that no privilege arises if any express transfer of rights under copyright has occurred;
- expands the privilege granted by §201(c), beyond what Congress intended, permitting its alienability; and
- misinterprets this Court's comments in *Tasini* as permitting for-profit microfilming and distribution of

microform products even though §108 only permits microfilming for archival purposes and only by a limited class of persons.

The Second Circuit's decision causes extraordinarily harsh and unreasonable results and upsets the delicate balance Congress sought to achieve between the interests of authors and publishers. Most disconcerting is the fact that the Second Circuit's decision on these questions encourages use of the product of authors' creative energies beyond contractually permitted uses without compensation.

Amici request that this Court address these questions when it accepts *certiorari*.

REASONS FOR GRANTING THE PETITION

The reasons identified by the Petitioners and the Respondents for granting this Petition demonstrate that review is required. They include that:

a) A direct conflict exists between the decisions of the Second Circuit and the Eleventh Circuit Court of Appeals on the same important matier involving the same primary defendants and the same products.

b) The Second Circuit's decision is marked by egregious error; misapplications of this Court's teachings; a complete departure from established principles of law and from the accepted and usual course of judicial proceedings.

c) The Second Circuit's decision causes extraordinarily harsh and unreasonable results.

d) The Second Circuit substituted its judgment about consumer perception for that of the trier of fact in finding that consumers would conclude that the CNG is merely a new version of the individual monthly magazine issues.

e) The Second Circuit's decision frustrates the objectives of the Copyright Act and of Article 1, § 8, cl. 8 of the Constitution.

f) The issues raised by the Petitions have been in dispute for over 12 years and have consumed millions of dollars in attorneys' fees, and unnecessarily consume the resources of litigants and the courts.

g) The resolution of other cases await this Court's guidance.

i) Publishers and authors await clear guidance about what they can and cannot do and any further delay inhibits commerce and the public interest.

h) The dispute is in high focus and the record is fully developed; a decision is needed now and no better opportunity is likely to come available where two circuits are split on the same issues and products.

This Court can and should make clear the scope of the privilege created by §201(c).

Beyond the reasons identified above, *Amici* believe that three other rulings by the Second Circuit are wrong and dangerous in their impact. These rulings relate to:

1) the affect of contracts between authors and publishers on the publisher's privilege;

2) whether the privilege is alienable; and

3) whether the §108 archival microfilming exemption from copyrightablitity was somehow expanded by this Court's *Tasini* decision.

The Second Circuit's rulings with respect to these additional issues have the pernicious effect of undermining the well-recognized policies of the Copyright Act and the Constitution to protect and preserve the interests of authors and are inconsistent with the balance that Congress and this Court have sought to strike.

This Court needs to grant *certiorari* to clarify that author's and publisher's agreements supercede the statutory privilege which was created for instances where no such agreements exist; that the privilege granted publishers is personal and is not alienable; and that microfilm duplication and distribution for profit, not performed by libraries for archival purposes, does not qualify for the §108 exemption from copyright liability.

ARGUMENT

I. THE SECOND CIRCUIT MISCONSTRUED THE EFFECT OF CONTRACTS BETWEEN AUTHORS AND PUBLISHERS UPON THE §201(C) PRIVILEGE

Plaintiffs in each action under review expressly granted to NGS some rights under their copyrights in their works for the initial publication in the various NGMs. 17 U.S.C.§201(c), by its own terms, does not apply where there is any "express transfer of the copyright or of any rights under it." [2] Consequently, the §201(c) privilege does not apply and the right of NGS to use these Authors' works is governed by their express agreements.

This Court in *Tasini* confirmed that "Publishers and all others can protect their interests by private contractual arrangement." *Tasini*, 533 U.S. at 502.

The Second Circuit ignored this Court's guidance and the fact that, by contracting with NGS to permit inclusion of

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[2] The complete text of 17 U.S.C. § 201(c) provides:

> (c) Contributions to Collective Works. — Copyright in each separate contribution to a collective work is distinct from copyright in the collective work as a whole, and vests initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective work, any revision of that collective work, and any later collective work in the same series.